

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND, BOB CICHON,
MARK SMITH, DALE BLACKSON, DAVID WEIS,
JAMES R. CHURCH, and MIKAL R. GILGER

Appeal 2007-2252
Application 09/505,594
Technology Center 3600

Decided: November 2, 2007

Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and DAVID B.
WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-11, 45, and 46. We have jurisdiction under 35 U.S.C. § 6(b) (2002). This appeal includes a record that is not ripe for review and, pursuant to 37 C.F.R. § 41.50(a)(1) (2006), we remand this application to the Examiner to take appropriate

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action consistent with our comments below. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2006).

In the Final Office Action mailed August 10, 2004, the Examiner took Official Notice

that the step wherein a transaction function device is operative to communicate a device driver from the transaction function device to the data store for storage in the data store is old and well known in the art. Communication of a device driver from the device to a data store helps in synchronization of transaction events making the process more efficient.”

(Final Office Action 4). Appellants challenged the taking of Official Notice as unsupported by any evidence and argued that it constitutes “[a]n assertion of basic knowledge and common sense . . . not based on any evidence in the record [that] lacks substantial evidence support.” (Br. 14).

The Examiner responded by producing an additional reference, listed in the “**Evidence Relied Upon**” section of the Answer as “JINI (™) Device Architecture Specification, Sun Microsystems, Revision 1 (January 25, 1999) pp 1-14.” (Answer 3).¹ The Examiner did not modify the original rejection to include the

¹ The Examiner initially issued an Answer on June 8, 2005. This Answer was rejected by the Board in part for clarification under *the Manual of Patent Examining Procedure (MPEP)* § 1211 regarding the pertinence of the Jini Device Architecture Specification listed on pages 8 and 9 of that Examiner's Answer and to consider whether that reference should be listed under the heading “Evidence Relied Upon” (Order Returning Undocketed Appeal to Examiner 2). All references to the Examiner's Answer in the body of this decision refer to the Examiner's Answer mailed December 22, 2005 in response to the Board's order.

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added reference, and reasserted the original rejection of claims 1-11, 45, and 46 as unpatentable over U.S. Patent Number 6,311,165 to Coutts et al. without change. He reiterated the contested taking of Official Notice (Answer 4). In the “Response to Argument” section of the Answer, the Examiner stated that

In support of the official notice taken, the examiner would like to direct the Appellant's attention to the Jini Device Architecture Specification Reference. In pages 6-8 of the Jini Device Architecture Specification Reference is disclosed JINI technology wherein intelligent peripherals using Java virtual machine (JVM) communicate Java objects and codes with other peripherals through the RMI interface and layer. The motivation to combine these steps is that each of the operating modules (peripheral devices) can be conveniently and independently updated using JAVA executable program code. This motivation can be found in Coutts Column 3 lines 18-26.

(Answer 8-9). The Examiner further asserted that “the cited reference in combination with the provided support for the official notice taken discloses all the features and relationships that are claimed.” (Answer 9).

It is not clear from the Examiner’s Answer whether the Examiner intended to rely on the JINI (TM) Device Architecture Specification as an additional reference in support of the obviousness rejection or merely as evidentiary support for the earlier Official Notice, particularly in light of the Examiner’s reference to “the cited reference in combination with the provided support for the official notice taken” (Answer 9). Clarification is required.

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The Examiner also failed to respond to the Appellants' assertion that the JINI (TM) Device Architecture Specification does not qualify as prior art (Reply Br. 7-8). In particular, the Appellants argued that

nowhere in the present Answer does the Office even attempt to address, let alone establish, that the Sun Microsystems reference qualifies as prior art.

The present application claims the benefit of U.S. Provisional Patent Application No. 60/120,506 filed February 17, 1999 pursuant to 35 U.S.C. 119(e), and the rejected claims are fully supported by this provisional patent application. Although the Sun Microsystems reference includes a Revision 1.0 date which is purportedly January 25, 1999, neither the Sun Microsystems reference nor the Answer provide [sic, provides] any evidence whatsoever as to when the Sun Microsystems reference was actually completed or publicly available.

(Reply Br. 8). The Examiner noted the filing of the Reply Brief, but deemed no further response necessary (Detailed Action mailed April 20, 2006).

ORDER

Accordingly, it is ORDERED that the application is remanded to the Examiner:

- 1) to clarify whether the Examiner intended to enter a new ground of rejection over Coutts in view of the JINI (TM) Device Architecture Specification;
- 2) to clarify whether the JINI (TM) Device Architecture Specification qualifies as prior art;

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3) to prepare a supplemental examiner's answer in response to the Reply Brief; and

4) for such further action as may be appropriate.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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